REMARKS

In the Office Action, the Examiner rejected claims 24-28. However, the Examiner allowed claims 1-23 and 29-34. By the present Response, Applicants amend claim 24. Upon entry of the amendments, claims 1-34 will remain pending in the present patent application. Reconsideration and allowance of all pending claims are requested.

Information Disclosure Statement

In the Office Action, the Examiner acknowledged receipt and consideration of copies of a number of applications related to the above-identified application. The Examiner also requested that Applicants submit, with this Response, a new Form PTO-1449 listing the related applications so the Examiner may indicate consideration of these applications for the record. Pursuant to this request, such a Form PTO-1449 is enclosed herewith.

Rejections Under 35 U.S.C. § 102

In the Office Action, the Examiner rejected claims 24 and 26-28 under 35 U.S.C. § 102(b) as being unpatentable over Vivers (U.S. Patent No. 5,672,943). Applicants respectfully traverse this rejection.

A *prima facie* case of anticipation under 35 U.S.C. § 102 requires a showing that each limitation of a claim is found in a single reference, practice or device. *In re Donohue*, 226 U.S.P.Q. 619, 621 (Fed. Cir. 1985). Accordingly, Applicants need only point to a single element not found in the cited reference to demonstrate that the cited reference fails to anticipate the claimed subject matter. The prior art reference also must show the *identical* invention *"in as complete detail as contained in the ... claim"* to support a *prima facie* case of anticipation. *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989).

Applicants respectfully submit that the Vivers reference fails to disclose each and every element of independent claim 24 as amended and, therefore, fails to support a *prima facie* case of anticipation. For instance, as amended above, independent claim 24 recites, *inter alia*, "a database including data representative of function and location *of a plurality* of programmable electrical components in an installation" (emphasis added). The recitations of the instant claim also include, "a configurator adapted to *select* data pertaining to one of the plurality of programmable electrical components from the database" (emphasis added). As discussed immediately below, such elements are missing from the Vivers reference.

The Vivers reference is directed to addressing problems associated with installing control units associated with functional units such as motors or distribution panels. *See* col. 1, lines 42-62. The cited reference indicates that these control units are distributed on a one-to-one basis with individual items of installed equipment. Col. 1, lines 17-23. In the system disclosed in the Vivers reference, a control unit contains the parameters specific to *that individual item of equipment. Id.* Thus, each control unit would contain information related to one and only one piece of equipment, such as a single motor. These control units, such as control units 13, 23, and 33 of the present reference, include memories which contain the location address of a respective functional unit. Col. 2, lines 34-39. The Vivers reference also teaches the use of non-volatile memory modules 15, 25, and 35 with control units 13, 23, and 33. *See* col. 2, lines 44-46. As is evident in the sole figure of the reference, each memory module is associated with a single control unit. *See also id.* Further, each memory module is permanently associated with *one* functional unit. Col. 2, lines 52-55. When a control unit is installed, data related to *a single* functional unit associated with *a single* memory module, such as motor M1, may be transferred from the respective memory module to that particular control unit. Col. 2, line 66 – col. 3, line 9.

First, the Vivers reference does not disclose "a database including data representative of function and location of a plurality of programmable electrical components

in an installation," as recited by independent claim 24. As discussed above, each memory module and control unit of the instant reference only contains data related to *a single functional unit*. Consequently, neither the memory module nor the control unit of the Vivers reference can be equated with "a database including data representative of function and location *of a plurality of programmable electrical components*" (emphasis added).

Secondly, the Vivers reference also fails to disclose "a configurator adapted to select data pertaining to one of the plurality of programmable electrical components from the database." In the system disclosed in the Vivers reference, a control unit may receive address, status, and configuration data from an associated memory module. Col. 3, lines 6-9. Further, *all* of the data loaded into the memory module is *automatically* transferred to the respective control unit. *Id.* Because this data transfer is automatic and absolute, the memory module of the Vivers reference cannot be said to select which data to transmit. Thus, the memory module disclosed in the Vivers reference cannot be considered "a configurator adapted to *select data pertaining to one of the plurality of programmable electrical components* from the database" (emphasis added).

Consequently, because the reference fails to disclose each and every element of the present claim, Applicants respectfully submit that independent claim 24 is allowable over the Vivers reference. Furthermore, claims 26-28 depend from independent claim 24. As a result, claims 26-28 are believed to be allowable based not only on their dependency from an allowable base claim, but also for the subject matter recited in each dependent claim. Accordingly, Applicants respectfully request withdrawal of the Examiner's rejection and allowance of claims 24 and 26-28.

Rejections Under 35 U.S.C. § 103

In the Office Action, the Examiner rejected claim 25 under 35 U.S.C. § 103(a) as being unpatentable over Vivers. Applicants respectfully traverse this rejection.

The burden of establishing a *prima facie* case of obviousness falls on the Examiner. *Ex parte Wolters and Kuypers*, 214 U.S.P.Q. 735 (PTO Bd. App. 1979). Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention absent some teaching or suggestion supporting the combination. *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 1577, 221 U.S.P.Q. 929, 933 (Fed. Cir. 1984). Accordingly, to establish a *prima facie* case, the Examiner must not only show that the combination includes *all* of the claimed elements, but also a convincing line of reason as to why one of ordinary skill in the art would have found the claimed invention to have been obvious in light of the teachings of the references. *Ex parte Clapp*, 227 U.S.P.Q. 972 (B.P.A.I. 1985).

As discussed above, the Vivers reference fails to disclose each and every element of independent claim 24, from which claim 25 depends. Consequently, because it does not disclose each element, the Vivers reference cannot support a *prima facie* case of obviousness. As a result, claim 25 is allowable on the basis of its dependency from allowable independent claim 24, as well as by virtue of the subject matter separately recited in the dependent claim. Accordingly, Applicants also respectfully request withdrawal of the Examiner's rejection and allowance of claim 25.

Conclusion

Applicants thank the Examiner for allowing claims 1-23 and 29-34 and respectfully request allowance of all pending claims in view of the remarks and amendments set forth above. If the Examiner believes that a telephonic interview will help speed this application toward issuance, the Examiner is invited to contact the undersigned at the telephone number listed below.

Respectfully submitted,

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